

REMARKS

CLAIM STATUS

Claims 1-21 were pending in this application. Claims 1, 9, 10, 13, and 17 are amended herein. Claims 7, 8, 15, 16, and 20 are cancelled, without prejudice, with this amendment. Claims 22-26 have been added. Therefore, claims 1-6, 9-14, 17-19, and 21-26 remain pending in this application.

REJECTIONS

35 U.S.C. §102(b)

The examiner has rejected claims 1-6, 13, and 14 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,678,267 to Kinder (hereinafter “Kinder”). Claims 1 and 13 have been amended in this response. Applicants respectfully request that the rejection be reconsidered in light of the amendments. Claim 1 has been amended to add the limitations of original dependent claims 7 and 8. Claim 13 has been amended to include the limitations of dependent claims 15 and 26. As amended, claims 1 and 13 recite, among other things, a carriage “wherein the carriage comprises an upwardly-opening socket, and the patient care equipment rack comprises a downwardly-extending post configured for reception in the socket, wherein the socket has a tapered inner surface that varies in width from wide to narrow in a downward direction, and the post has a complementary outer surface.” Kinder fails to disclose a carriage and socket as recited in amended claims 1 and 13. In fact, Kinder fails to disclose any socket whatever. The 35 U.S.C. §102(b) rejection of amended claims 1 and 13 as anticipated by Kinder should be withdrawn for at least this reason. Claims 2-6 depend from claim 1. Claim 14 depends from claim 13. The 35 U.S.C. §102(b) rejection of amended claims 2-6 and 13 as anticipated by Kinder should be withdrawn for at least this reason.

35 U.S.C. §103

The Examiner has rejected claims 1, 7, 9-11, 13 and 15 under 35 U.S.C. §103(a) as obvious over JP 03-151971 to Katsuyoshi (hereinafter Katsuyoshi) in view of Kinder. Claims 1 and 13 have been amended as discussed with regard to the 35 U.S.C. §102(b) rejection above. Claim 1 now includes the limitations of original claim 8. Claim 13 now includes the limitations of original claim 16. The Examiner has rejected both claim 8 and claim 16 as obvious over Katsuyoshi in light of Kinder and further in light of U.S. Patent No. 277,444 to Montgomery (hereinafter Montgomery). Applicants respectfully traverse the rejection of the limitations of claim 8 and 16 which are found in amended claims 1 and 13 respectively.

The rejection is improper because in combining Katsuyoshi, as best understood, and Kinder with Montgomery the Examiner has failed to perform the obviousness analysis as required under *KSR Int'l. Co. v. Teleflex, Inc. et al.*, 127 S.Ct. 1727 (2007). The Supreme Court in *KSR* reaffirmed that certain principles govern the analysis of obviousness. One such principle is that when “determining whether claimed combination of elements known in prior art would have been obvious [examiners] will often be required to look to interrelated teachings of multiple patents, effects of demands known to design community or present in marketplace, and background knowledge of person of ordinary skill in art in order to determine whether there was apparent reason to combine known elements in manner claimed in patent in suit, and in order to facilitate review, this analysis should be made explicit.” *KSR Int'l. Co. v. Teleflex, Inc. et al.*, 127 S.Ct. 1727, 1741 (2007). The *KSR* court emphasized the need for the examiner to engage in an explicit analysis of obviousness; as the Court stated: “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR*, 127 S.Ct. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

In support of the rejection, the Examiner asserted “[i]t would have been obvious to... incorporate the tapered end post and complementary socket as taught by Montgomery for the purpose of aligning and receiving complementary part[s] for engagement.” 8/7/2008 Official Action, page 5. The Examiner has offered no evidence supporting the proposed reason to combine. For example, the Examiner did not offer evidence of “demands known to the design community or present in the market place.” *KSR*, 127 S.Ct. 1727, 1741 (2007). The Examiner did not discuss how the “background knowledge possessed by a person of ordinary skill in the

art” led the Examiner to conclude there was a reason to combine. *Id.* In fact, neither Kinder, Katsuyoshi, nor Montgomery teach a problem related to alignment. Montgomery wholly fails to teach that the tapered inner surface of the socket is for the purpose of alignment.

Montgomery requires that “[t]he handle is attached to the broom by inserting the tapering end thereof into the tapering socket and then turning it toward the right, and at the same time forcing it down into the socket.” Montgomery, lines 35-39. Therefore, the handle must be manually aligned and inserted into the broom to facilitate engagement. The taper of the socket is not used for alignment but rather to ensure an interference fit between the handle and the broom when the handle is pushed down into the broom and screwed in. Katsuyoshi, as best understood, teaches a round post that slides into a complementary round socket when manually aligned therewith. Additionally, Katsuyoshi, as best understood, teaches a separate clamping lock mechanism to hold the post in the socket. The Examiner has offered no reason why it would have been obvious to combine an interference fit engagement mechanism with the slidable post and socket engagement of Katsuyoshi. These omissions show that instead of detailing a “rational underpinning to support the legal conclusion of obviousness,” the Examiner has offered merely an unsupported conclusory statement. Thus, the Examiner has failed to engage in the explicit analysis required by *KSR*; as such, the Examiner’s 35 U.S.C. §103(a) obviousness rejection of amended claim 1 and amended claim 13 is improper and should be withdrawn.

Additionally, the rejection is improper because the Examiner has failed to perform the factual inquiry as required under *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). In *KSR Int’l. Co. v. Teleflex, Inc. et al.*, 127 S.Ct. 1727 (2007), the United States Supreme Court clarified the test for obviousness. This decision has been codified for use by patent examiners throughout MPEP 2100. The Supreme Court in *KSR* reaffirmed that certain principles govern the analysis of obviousness. One principle reaffirmed in *KSR* is that the question of obviousness must be resolved on the basis of the factual inquiries enunciated by the Supreme Court in its landmark *Graham* decision. The first of such factual inquiries is a determination of the scope and content of the prior art. In support of the rejection, the Examiner did not fully evaluate the scope and content of Montgomery. The Examiner misinterprets the scope and content of Montgomery in applying the tapered handle and broom as an alignment mechanism for Katsuyoshi. Montgomery does not teach that a tapered inner surface of a socket that may be employed for encouraging alignment. Montgomery requires that “[t]he handle is attached to the

broom by inserting the tapering end thereof into the tapering socket and then turning it toward the right, and at the same time forcing it down into the socket.” Montgomery, lines 35-39. Therefore, the handle must be manually aligned and inserted into the broom to facilitate engagement. Further, the taper of the socket is not used for alignment but rather to ensure an interference fit between the handle and the broom when the handle is pushed down into the broom and screwed in. The Examiner misinterprets Montgomery as teaching a mechanism for alignment. Rather, Montgomery is a mechanism for locking two components together. Therefore, the factual determination of the scope and content of the prior art does not support a finding of obviousness. Thus, the 35 U.S.C. §103(a) obviousness rejection of amended claims 1 and 13 is improper and should be withdrawn.

Still yet, Montgomery teaches away from combination with Katsuyoshi, as best understood. In *KSR*, the Supreme Court emphasized the “principle that when the prior art teaches away from combining certain known elements, discovery of successful means of combining them is more likely to be nonobvious” in *KSR*. *KSR*, 1740 (citing *U.S. v. Adams*, 383 U.S. 39, 51-52 (1966)). Montgomery teaches away from a post that is intended to be easily engaged and that continuously and repeatably aligns the post with the socket which are objectives of Katsuyoshi, as best understood. Montgomery discloses “[t]he handle is attached to the broom by inserting the tapering end thereof into the tapering socket and then turning it toward the right, and at the same time forcing it down into the socket. By this movement the wire screw will secure a hold in the socket and prevent the handle from being withdrawn. To withdraw the handle it will only be necessary to unscrew and pull the handle at the same time.” Montgomery, lines 35-44. Montgomery relies on the locking taper effect of the tapered handle and socket as a mechanical relationship intended to fix the handle to the socket. When the tapered end of the handle is screwed into the socket they come into intimate contact. The conical tapered end of the handle compresses the walls of the socket as it expands and changes shape to accommodate the handle. The compression in the socket acting on the tapered end of the handle keep both components fixed together. Montgomery teaches away from an easily engaged post as disclosed in Katsuyoshi, since in order to engage the post it must be both pushed and screwed into the socket rather than simply lowered. Montgomery requires turning the handle as it is engaged thus changing the alignment of the handle during engagement preventing continuous alignment of during engagement. The engagement of the handle changes the geometry of the

broom socket upon each successive use of the taper leading to slightly different alignment of the post after each engagement preventing repeatable alignment upon completed engagement. For at least these reasons, Montgomery teaches away from combination with Katsuyoshi, as best understood, and Kinder. The 35 U.S.C. §103(a) rejection of claims 1 and claim 13 over Katsuyoshi in view of Kinder and further in view of Montgomery should be withdrawn for at least this reason.

The Examiner rejected claims 17-19 and 21 under 35 U.S.C. §103(a) as obvious over U.S. Patent 5,802,636 to Corbin in view of Katsuyoshi. Independent claim 17 has been amended to recite all of the limitations of cancelled dependent claim 20. Claim 17 as amended recites, among other things, “a carriage coupled to the rail for movement along the rail, the carriage having an upwardly-opening socket for receiving the downwardly-extending post of the patient care equipment rack so that the patient care equipment rack engages with the carriage as the upper frame is raised or the support structure lowered while the downwardly-extending post is generally aligned with the upwardly opening socket, wherein the socket has a tapered inner surface that varies in width from wide to narrow in a downward direction, and the post has a complementary outer surface.” The Examiner has rejected claim 20 as obvious over Corbin in light of Katsuyoshi and further in light of Montgomery.

The Applicants respectfully traverses the rejection of amended claim 17, including the limitation of originally filed claim 20, as improper. The rejection is improper because in combining Corbin with Katsuyoshi with Montgomery the Examiner has failed to perform the obviousness analysis as required under *KSR Int'l. Co. v. Teleflex, Inc. et al.*, 127 S.Ct. 1727 (2007). In support of the rejection, the Examiner asserted “[i]t would have been obvious to... have incorporated the tapered end post and complementary socket as taught by Montgomery for the purpose of aligning and receiving complementary part[s] for engagement.” 8/7/2008 Official Action, page 7. Corbin wholly fails to disclose a post and socket as recited in amended claim 17. The rejection therefore relies on the combination of Katsuyoshi and Montgomery to teach the post and socket limitations. The arguments with regard to the Examiner’s improper combination of Katsuyoshi and Montgomery from above are reiterated here. Namely, the Examiner has failed to make the explicit analysis as required *Kahn* and reiterated in *KSR*. The Examiner has failed to consider the scope and content of the prior art as required by *Graham* and reiterated in *KSR*.

Finally, Montgomery teaches away from the combination. The 35 U.S.C. §103(a) rejection of amended claim 17 is improper and should be withdrawn from at least these reasons.

In light of the foregoing discussion, it is believed that independent claims 1, 13, and 17 are in condition for allowance. It is further believed that the 35 U.S.C. §103(a) rejections of dependent claims 2-6, 9-12, 14, 18, 19, and 21 are moot in light of the foregoing discussion and amendments to independent claims 1, 13, and 17.

In the event that the Examiner applies Katsuyoshi in support of additional rejections, Applicants respectfully requests that the Examiner provide a translation of the cited JP 03-151971 document. The Board of Patent Appeals and Interferences has held “[i]n our view, obtaining translations is the responsibility of the examiner.” *Ex Parte Jones*, 62 USPQ2d 1206, 1208-09 (B.P.A.I. 2001)(unpublished). The Board further held that “review by the examiner and applicant of translations of the prior art relied upon in support of the examiner’s rejection may supply additional relevant evidence.” *Id.* Applicants respectfully contend that additional information useful to determining the applicability of 35 U.S.C. §103(a) may be available within the text of the reference which is currently unavailable to the Applicants.

Claims 22-26 have been added and recite additional limitations regarding the structure of the socket and post. Support for the limitations can be found at least in Fig. 2 and page 6, lines 18-24 of the originally filed application.

CONCLUSION

In view of the forgoing, it is submitted that this application is in condition for allowance. Allowance is respectfully requested. If the Examiner believes that a telephonic interview would expedite the allowance of this application, she is requested to contact the undersigned for prompt resolution of any outstanding issues.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and that

shortages in fees, if any, be charged, or any overpayment in fees credited, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 with reference to file 7175-74604.

Respectfully submitted,

BARNES & THORNBURG LLP

A handwritten signature in black ink, appearing to read "Scott M. Simmonds", is written over a horizontal line.

Scott M. Simmonds
Registration No. 55620
Attorney for Applicants

Indianapolis, Indiana
(317) 231-7403
scott.simmonds@btlaw.com